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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/336,612 06/18/99 BENDINER

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EXAMINER
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IM22/1126

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CROSS, L	
ART UNIT	PAPER NUMBER

1721

DATE MAILED:

11/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# **Office Action Summary**

Application No.  
**09/336,612**

Applicant(s)  
**Bendiner**

Examiner  
**LaToya Cross**

Group Art Unit  
**1721**



☒ Responsive to communication(s) filed on Jun 18, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## **Disposition of Claims**

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) 3-5 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 and 2 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-5 are subject to restriction or election requirement.

## **Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## **Priority under 35 U.S.C. § 119**

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## **Attachment(s)**

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 2, drawn to an aqueous solution composition, classified in class 252, subclass 400.1.
  - II. Claims 3-5, drawn to a concentrated form of aqueous solution, classified in class 252, subclass 397.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are two different solutions containing different components. Since the solutions comprises different components, it would be expected that the solutions would have different effects. Thus, the two solutions are independent, one from the other.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with F. David AuBuchon on November 3, 1999 a provisional election was made without traverse to prosecute the invention of group I, claims 1 and 2. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-5 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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*Claim Rejections - 35 USC § 103*

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 3,630,226 to Develter (herein referred to as Develter '226).

Applicants' claimed invention is directed to a solution comprising potassium sorbate dissolved in water at a specified concentration of at least 0.3% by weight and having a pH of at least 4.5.

Develter '226 discloses a solution comprising a biodegradable salt such as 2, 4 hexadienoic acid potassium salt (potassium sorbate) which is dissolved in water such that the solution has a salt concentration of about 0.3, preferably 0.3-0.35% by weight. The solution is disclosed as having a pH of about 4.2. See col. 4, lines 27-41.

Develter '226 differs from the instantly claimed invention in that tap water or deionized water is not mentioned in particular. Also, the pH disclosed by the reference is slightly lower than that instantly claimed by Applicants.

With respect to the particular type of water, Develter '226 does not specifically disclose tap or deionized water. However, one of ordinary skill in the art would expect that any water

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suitable to dissolve the potassium sorbate would be appropriate. Absent evidence to the contrary, Applicants' claimed use of tap or deionized water specifically would not provide unexpected results.

With respect to the pH, Develter '226 discloses a pH of about 4.2, while Applicants' claim a pH of greater than 4.5. The pH of the reference is similar to the pH instantly claimed. Although there exists a difference, the differences in pH of the reference and that instantly claimed is very small. It is believed that the pH of the instantly claimed invention would not provide unexpected results, absent evidence to the contrary.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103, in view of the teachings of Develter '226.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,354,902 to Merciadet et al (hereinafter referred to as Merciadet et al '902).

Applicants' claimed invention is directed to a solution comprising potassium sorbate dissolved in water at a specified concentration of at least 0.3% by weight and having a pH of at least 4.5.

Merciadet et al '902 discloses stabilized sorbic acid and salts thereof. Merciadet et al '902 discloses aqueous solutions of sorbic acids and salts such as potassium sorbate. The amounts of potassium sorbate in solution are disclosed as being from 0.005 to about 5% by weight (col. 1, lines 4-13). Also included in the compositions of Merciadet et al '902 is a

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buffering system to maintain pH of 4 to 5.5 (col. 1, lines 34-44). Each example teaches the potassium sorbate being dissolved in deionized water.

Merciadez et al '902 differ from the instantly claimed invention in that there is no specific example showing the use of potassium sorbate being dissolved in water at a concentration such as instantly claimed by Applicant. However, at col. 3, lines 4-13, Merciadez et al '902 clearly teach a range of 0.005-5% by weight for potassium sorbate. Thus, it would have been obvious to one of ordinary skill in the art to use Applicants' instantly claimed concentration of 0.3% by weight, since this amount is encompassed by the reference.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious, within the meaning of 35 USC 103, in view of the teachings of Merciadez et al '902.

#### *Citation of Relevant Prior Art*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabrielle Brouillette, can be reached at (703) 308-0756. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC *SIC*  
November 19, 1999

  
**GABRIELLE BROUILLETTE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1700**